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TOWNSEND and TOWNSEND and CREW LLP

By: 

AMENDMENT UNDER 37 CFR 1.116
EXPEDITED PROCEDURE –
EXAMINING GROUP 3692

PATENT

Attorney Docket No.: 020425-105100US

Client Ref. No.: SCHB-4100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Olga Milosavljevic

Application No.: 09/880,170

Filed: June 12, 2001

For: SYSTEM AND METHOD FOR
INCOME PLANNER

Customer No.: 20350

Confirmation No. 5814

Examiner: Ojo O. Oyeibisi

Technology Center/Art Unit: 3696

AMENDMENT UNDER 37 CFR 1.116
EXPEDITED PROCEDURE EXAMINING
GROUP 3696

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action mailed April 24, 2008 on the above-referenced application, please enter the following amendments and remarks:

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 7 of this paper.

Amendments to the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. (Currently amended) A method for forecasting a likelihood that a customer's assets held in a plurality of different types of customer accounts at retirement meet in-retirement goals, including, but not limited to, an annual income withdrawal goal, an estate goal, and a years in retirement goal, comprising:

inputting said income withdrawal goal, said estate goal, said years in retirement goal, and a current asset allocation, and identifying one of said in-retirement goals as a priority goal;

performing an analysis based on said in-retirement goals and said current asset allocation;

forecasting, by using results of said analysis, said likelihood that said customer assets at retirement meet said priority goal;

providing an in-retirement income stream withdrawal strategy, wherein said income stream withdrawal strategy provides tax advantages and wherein said income stream withdrawal strategy provides for a first time period and said income stream withdrawal strategy avoids withdrawal of assets from tax deferred accounts during the first time period, and said income stream withdrawal strategy providing for withdrawal from one or more tax deferred accounts during a second time period; and

providing a findings overview report based on said analysis, wherein the findings overview report includes the in-retirement goals, and the likelihood that the priority goal will be met if the in-retirement income stream withdrawal strategy is followed, and the findings overview report further including an asset drawn down schedule which shows a predicted end of year account balance for each of the plurality of different types of customer accounts if the in-retirement income stream withdrawal strategy is followed;

projecting annual snapshot cash flows from said current asset allocation and determining if a gap exists between said projected cash flows and said income goal; and providing a current performance planning table, wherein said table allows for assessing approximate current yield and total return information in order to determine which holdings of said assets provide cash flow versus growth required to meet said in-retirement goals, and further wherein said current performance planning table includes information on each asset's annual income, 1-year and 5-year total returns, and current value.

2. (Original) The method of Claim 1, wherein said forecasting is based on outside and inside holdings.

3. (Canceled)

4. (Currently amended) The method of Claim 3 1, wherein said cash flows comprise dividend and interest sources, and non-fluctuating sources.

5. (Original) The method of Claim 4, wherein said dividend and interest sources comprise equity dividend, fixed income, and cash payments, and wherein said non-fluctuating sources comprise income property, social security, and pension payments.

6. (Canceled)

7. (Currently amended) The method of Claim 3 1, further comprising generating a current summary showing a breakdown of said cash flow into said dividend and interest sources, said non-fluctuating sources, total cash flow, and said income goal.

8. (Canceled)

9. (Previously Presented) The method of Claim 1, wherein said withdrawal strategy further comprises designating when and how much to withdraw from taxable, 401K, traditional IRA, and Roth IRA accounts.

10. (Canceled)

11. (Currently amended) The method of Claim 3 1, further comprising determining required minimum distribution (RMD) income streams based on total value of tax deferred assets.

12. (Previously Presented) The method of Claim 11, further comprising generating a report showing annual tax-deferred account withdrawals, and year end tax deferred account balances.

13. (Currently amended) The method of Claim 3 1, further comprising providing financial and non-financial alternatives in order to attempt to increase said likelihood of meeting said retirement goals.

14. (Original) The method of Claim 13, wherein said non-financial alternatives increase said likelihood by requiring a relaxing of at least one of said in-retirement goals.

15. (Original) The method of Claim 13, wherein said financial alternatives attempt to increase said likelihood by altering said asset allocation and thereby assuming a better diversified portfolio.

16. (Previously Presented) The method of Claim 14, further comprising generating a report showing said in-retirement goals and said likelihood versus said modified in-retirement goals, said modified in-retirement goals comprising said at least one of said relaxed in-retirement goals, and showing said subsequent possible increased likelihood.

17. (Previously Presented) The method of Claim 15, further comprising generating a report showing said in retirement goals and said likelihood versus said altered asset allocation, and showing said subsequent possible increased likelihood.

18. (Original) The method of Claim 15, wherein asset allocation preferences are incorporated.

19. (Previously Presented) The method of Claim 15, further comprising providing action plans for attempting to increase said likelihood, said action plans comprising means for conveying whether to buy or sell said assets.

20. (Previously Presented) The method of Claim 19, wherein each asset class holding is separated from each other and small company holdings are separated from large, international, and fixed income company holdings.

21-35. (Canceled)

36. (Previously Presented) The method of claim 1 further comprising providing a performance planning report which identifies each of the assets held in the customer accounts and provides a projected annual cash flow, an approximate current yield, a historical total return, and an approximated current value for each asset, to assist the customer in assessing their assets on an income versus growth basis.

37. (Canceled)

38. (Canceled)

39. (Previously Presented) The method of Claim 2, further comprising acquiring an asset's current price through an existing, internal data feed updated nightly.

40. (Currently amended) The method of Claim 3 1, further comprising alerting a user when a cash flow analysis indicates a problematic fluctuation.

41. (Previously Presented) The method of Claim 40, wherein the problematic fluctuation is indicated by a period wherein an actual monthly cash flow generated falls below a monthly cash flow goal by five percent or more.

42. (Canceled)

43. (Currently amended) The method of Claim 6 1, further comprising the step of calculating a percentage of dividends a customer is currently reinvesting versus accessing.

44. (New) The method of claim 14 wherein the relaxing of at least one of said in-retirement goals comprises relaxing the estate goal.

REMARKS/ARGUMENTS

This Amendment is responsive to the Office Action mailed on April 24, 2008. Entry of this Amendment is requested.

Claims 1-2, 4-5, 7, 9, 11-20, 36, 39-41, and 43-44 are pending in the present application. In the Office Action, claims 1-7, 9-22, and 34-43 have been rejected. Claims 3, 6, 21, 22, 34, 35, 37, 38, and 42 have been canceled. Claim 1 has been amended to incorporate canceled claims 3, 6, and 42. Claims 4, 7, 11, 13, 40, and 43 have been amended to fix their dependencies. Claim 44 has been added. Support for newly added claim can be found in paragraph [0070] of the specification. No new matter has been added. Reconsideration of the rejected claims is respectfully requested.

The amendment to claim 1 *does not raise new issues, because it is the same as prior dependent claim 42*. Entry of this amendment is requested since it reduces issues for appeal.

I. 35 USC 103

Claims 1-2, 4-5, 7, 9, 11-20, 36, 39, and 43 are rejected as obvious over Corrin (US 2002/0035527 A1) and Longo. This rejection is respectfully traversed.

A. *current performance planning table*

Claim 1 has been amended to incorporate canceled claims 3, 6, and 42. Obviousness has not been established for independent claim 1 or any claims that are dependent thereon, since all limitations in the claims are not taught or suggested by the prior art. "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). MPEP 2143.03. For example, the cited art does not disclose the limitations of now cancelled claim 6, which have been incorporated into independent claim 1:

providing a current performance planning table, wherein said table allows for assessing approximate current yield and total return information in order to determine which holdings of said assets provide cash flow versus growth required to meet said in-retirement goals

In the prior amendment filed January 31, 2008, the Applicants argued (in reference to now cancelled claim 6) that obviousness has not been established, since all limitations in the claim are not taught or suggested by the prior art. However, in the Office Action dated April 24, 2008, the Examiner did not respond to the arguments. As noted by MPEP § 707.07(f):

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

Pursuant to MPEP § 707(f), Applicants request that the Examiner answer the substance of any arguments made for any rejections that are repeated in subsequent Office Actions.

As recited in the previous Office Action, although Examiner argues that Corrin at lines 081-0141 discloses the claimed limitations, in fact that section of Corrin teaches a Retirement Track Chart and Table that compare previous account balances and balances needed to meet requirement goals (See paragraph 0085 of Corrin). The chart and table appear to utilize and display total account value for different time points beginning with the first reported account value (See paragraph 0137 of Corrin). Nothing in the chart and table, however, disclose a table that allows for assessing approximate current yield and total return information to determine which holdings provide cash flow versus growth (See Fig. 7 of Application). Thus, Corrin and Longo do not teach independent claim 1, or the dependents thereon.

B. each asset's annual income, 1-year and 5-year total returns, and current value

Furthermore, the cited art does not disclose the limitation of claim 1 "wherein said current performance planning table includes information on each asset's annual income, 1-year and 5-year total returns, and current value." Applicant's argued that the cited references do not disclose such a limitation (in reference to now-cancelled claim 42) in the amendment filed on January 31, 2008. The Examiner did not respond to those arguments in the Office Action. In page 11 of the Office Action, the Examiner states that the limitation regarding information on a current performance planning table is "a descriptive non-functional element" and fails to give the claim patentable weight.

The Applicants respectfully disagree. Section 2106.01 of the MPEP defines "nonfunctional descriptive material" as:

Nonfunctional descriptive material that does not constitute a statutory process, machine, manufacture, or composition of matter and should be rejected under 35 U.S.C. 101. Certain types of descriptive material, such as music, literature, art, photographs, and mere arrangements or compilations of facts or data, without any functional interrelationship is not a process, machine, manufacture, or composition of matter.

As recited in the present application, "[t]he invention provides the customer with information that allows the customer to make decisions that fit their cash flow needs." See paragraph [0070]. The above claim limitation is entirely functional, since it provides the customer the information needed to forecast and make investment decisions. As recited in paragraph [0071], "[a]n objective of the preferred embodiment of the invention is to help customers create a personalized cash flow withdrawal plan by analyzing their existing assets and using a variety of investment products, and to provide more in depth and specific investment advice." Different information provided (for example, 1 year or 5 year returns) could lead to different performance metrics, and thus to different investment decisions. There is a "functional interrelationship" between the claim limitation and the forecast created by the claimed method. Therefore, the claim language is not a "descriptive non-functional element," and must be

accorded patentable weight. Furthermore, claim 1 is a method claim, and the step of " providing a current performance planning table" must be accorded patentable weight.

C. *findings overview report*

Corrin in view of Longo does not disclose

providing a findings overview report based on said analysis, wherein the findings overview report include[s] the in-retirement goals, and the likelihood that the in-retirement goals will be met if the in-retirement income stream withdrawal strategy is followed, and the findings overview report further including an asset drawn down schedule which shows a predicted end of year account balance for each of the plurality of different types of customer accounts if the in-retirement income stream withdrawal strategy is followed

(emphasis added) It is respectfully submitted that the overview report which shows a predicted effect of following the specific in-retirement income stream withdrawal strategy on the different types of accounts, in combination with the other elements of the claims provides a very significant advantage to the customers. Aspects of an embodiment of a findings overview report are shown in Fig. 4 of the present application, and discussed at paragraphs 93-96 of the present application

The Examiner argues that Corrin in view of Longo discloses a report with "meaningful saving goals, the effectiveness of the investor's current strategy, investment performance expectations, investment guidance encompass the in-retirement goals and asset drawn down schedule." See page 13 of the Office Action. This is an incorrect assumption. Paragraphs [0010-0011] cited by the Examiner disclose generalities, but not an "asset drawn down schedule" as recited in claim 1. An "asset drawn down schedule" can be a "bar chart [that] shows the amounts each of taxable (bottom) 209, tax deferred (middle) 210, and tax free (top) 211 withdrawals for the customer's end of year account balance 212 versus the customer's in-

retirement age." See paragraph [0095] of the present application. The cited passages of Corrin do not disclose any such schedule.

Corrin and Longo do not disclose end of the year account balances on a findings overview report, as claimed. Paragraphs [0095-0096] of Corrin disclose the calculation of income streams (i.e. total yearly withdrawal amounts), but not the calculation of end of year account balances for each of a plurality of different types of customer accounts as required by the asset drawn down schedule. Moreover, as described above, such data can be used in forecasting and investment strategy. As such, it is not just "information/data which can easily be included in an investment advisory report of Corrin without altering/changing the system of Corrin" as claimed by the Examiner on page 4 of the Office Action. Corrin is drawn to a different investment strategy than the claimed method. Changing the "information/data" would change the strategy, and thus Corrin teaches away from such modifications. As such, independent claim 1, and the dependents thereon, are allowable, at least for this reason.

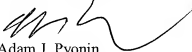
CONCLUSION

The cited art fails to teach or suggest not one or two, but at least three limitations in the broadest claim. Accordingly, there are many more reasons why the claims are patentable rather than unpatentable.

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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